

00862.003016



B/Image

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.)	
	:	Group Art Unit: 2854
Application No.: 09/374,580 ✓)	
	:	Allowed: January 27, 2004
Filed: August 16, 1999)	
	:	Confirmation No.: 3938
For: PRINTING HEAD, HEAD CARTRIDGE)	
HAVING PRINTING HEAD, PRINTING	:	
APPARATUS USING PRINTING HEAD,)	
AND PRINTING HEAD SUBSTRATE	:	June 10, 2005

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT
AND SECOND LETTER RE ERRONEOUS NOTICE OF ALLOWANCE

Sir:

A Notice of Abandonment issued on May 25, 2005 in the above-identified application, stating that the application has been abandoned because of Applicants' failure to timely pay the issue fee within the three-month statutory period set in the Notice of Allowance (PTOL-85) issued on January 27, 2004.

Applicants' undersigned attorney respectfully submits that the Notice of Abandonment was issued erroneously, because the Notice of Allowance in question was issued erroneously and hence the Issue Fee was not due on April 27, 2004. Rather, the Issue Fee was

timely paid in compliance with the statutory requirements therefor. The pertinent facts are as follows.

A Preliminary Amendment was filed on November 4, 2003, which amended certain claims and added certain claims.

Almost three months later, a Notice of Allowance was issued on January 27, 2004. (The total fees due in response to the Notice of Allowance were \$50, because an Issue Fee had been previously paid in response to a previous Notice of Allowance dated September 27, 2002, after which payment the application had been withdrawn from issue.)

The Notice of Allowance issued on January 27, 2004 was erroneously issued because the claims allowed therein were those that were pending in the application prior to the November 4, 2003 Preliminary Amendment. Accordingly, on February 17, 2004, Applicants filed a Letter re Erroneous Notice of Allowance (copy of same and date-stamped receipt postcard attached) explaining that the Notice of Allowance was erroneously issued and requesting examination of the Preliminary Amendment. As memorialized in the Letter re Erroneous Notice of Allowance, Applicants' representative contacted the U.S. Patent and Trademark Office (PTO) by telephone prior to filing that Letter and was told by the PTO that the Preliminary Amendment would be examined and that the application would be withdrawn from issue to do so, if necessary. On April 27, 2004, Applicants filed a further paper again requesting examination of the Preliminary Amendment (copy of same and return receipt for facsimile transmission attached). As mentioned in that paper, in further communications with the PTO Applicants' representative had been informed that the application would be withdrawn from issue for further review of Claims 59 and 64. Thus, Applicants understood that the application was being

withdrawn from issue and that the PTO acknowledged that the Notice of Allowance issued on January 27, 2004 was erroneously issued. Accordingly, no Issue Fee was due on April 27, 2004.

On November 30, 2004, Applicants received a Supplemental Notice of Allowability, indicating that the Preliminary Amendment had been considered and entered by the Examiner. Applicants did not receive a Supplemental Notice of Allowance, or any further communication from the PTO, until the instant Notice of Abandonment.

However, Applicants understand that the PTO was required to issue a Supplemental Notice of Allowance together with the Supplemental Notice of Allowability. 37 C.F.R. § 1.311. As noted above, the Notice of Allowance issued on January 27, 2004 did not allow the same set of claims allowed in the Supplemental Notice of Allowability, and additional examination on the merits occurred after issuance of the January 27, 2004 Notice of Allowance. As a result of that additional examination, the Examiner indicated that Applicants were entitled to a patent different from the one that would have issued based on the claims allowed in the January 27, 2004 Notice of Allowance. 37 C.F.R. § 1.311 states that “[i]f, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant” Since, after issuance of the Notice of Allowance on January 27, 2004, examination took place, and it was only as a result of that examination that the PTO determined that Applicants were entitled to the patent that would issue from the claims allowed in the Supplemental Notice of Allowability, it is submitted that under 37 C.F.R. § 1.311 the PTO was required to issue a Supplemental Notice of Allowance.

37 C.F.R. § 1.311 further states that “[t]he notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the

notice of allowance to avoid abandonment of the application.” Since no Supplemental Notice of Allowance was issued after issuance of the erroneously issued Notice of Allowance on January 27, 2004, no three-month period for payment of the Issue Fee was set. Accordingly, no Issue Fee was due, and no event (e.g., failure to timely pay the Issue Fee) occurred such as could legally authorize the PTO to hold the subject application abandoned.

Moreover, subsequent to Applicants’ receipt of the Supplemental Notice of Allowability, Applicants’ representative contacted the Examiner by telephone to clarify the status of the application because no Supplemental Notice of Allowance had been received. The Examiner indicated that he believed the application was being passed to issue. During the telephone conference, Applicants called the Examiner’s attention to the \$50 balance of the Issue Fee due, and the Examiner recommended that Applicants file a Letter Authorizing Charge of Deposit Account for Balance of Issue Fee within three months of the issue date of the Supplemental Notice of Allowability. Applicants duly filed such a Letter on February 25, 2005, authorizing the PTO to charge the \$50 balance of the Issue Fee.

Thus, Applicants were made to understand by the Examiner that his intention had been to issue a Supplemental Notice of Allowance, that he considered the Supplemental Notice of Allowability to function as a Supplemental Notice of Allowance, and that the application would pass to issue upon payment of the \$50 balance of the Issue Fee within three months of the issue date of the Supplemental Notice of Allowability.

Moreover, according to the Image File Wrapper of the subject application as accessed by Applicants’ undersigned attorney using PAIR, the Supplemental Notice of Allowability issued on November 30, 2004 is characterized as a “Notice of Allowance and Fee(s)

Due (PTOL-85)” (see attached copy of the table of contents from the Image File Wrapper).

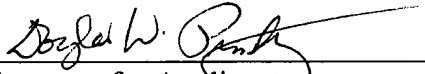
Accordingly, Applicants understand that the PTO deemed the Supplemental Notice of Allowability to be a Supplemental Notice of Allowance, and deemed the balance of the Issue Fee to be due three months after the issue date of the Supplemental Notice of Allowability, namely, on February 28, 2005. Since Applicants paid the balance of the Issue Fee on February 25, 2005, Applicants submit that, even if the Issue Fee were due three months after the issue date of the Supplemental Notice of Allowability, it was timely paid by Applicants. Since the Issue Fee has been timely paid, Applicants submit that the Notice of Abandonment was issued erroneously.

In conclusion, in view of the facts as set forth above, Applicants submit that the Notice of Abandonment was erroneously issued, because Applicants timely paid the Issue Fee. Since the Notice of Allowance dated January 27, 2004 was issued erroneously, because it failed to take into account the Preliminary Amendment (timely filed on November 4, 2003), no Issue Fee was due on April 27, 2004. Moreover, even had a fee been due, Applicants’ representative was informed that the application was being withdrawn from issue and, in fact, the application was withdrawn from issue for further substantive examination. Insofar as the balance of the Issue Fee could properly be deemed to have been due three months after the issue date of the Supplemental Notice of Allowability (i.e., on February 28, 2005), the balance of the Issue Fee due was paid by that date.

Accordingly, Applicants respectfully request that the Commissioner withdraw the erroneously issued Notice of Abandonment and the erroneously issued Notice of Allowance, and promptly pass the subject application to issue.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



Attorney for Applicants
Douglas W. Pinsky
Registration No. 46,994

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
DWP/tmc

DC_MAIN 205496v1



Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

Date 02, 16, 04
Mo. Day Yr.
Atty. Docket 00862 003016
Application No. 09/374,580

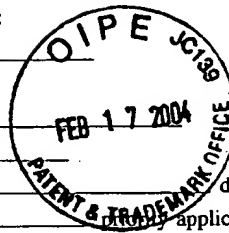
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Kindly acknowledge receipt of the accompanying:

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- ☐ Claim for priority and certified copies of _____ applications
- ☐ Issue fee transmittal and Check for \$ _____

☒ Other (specify) Letter re: Erroneous Notice of Allowance
by placing your receiving date stamp hereon and returning to deliverer.

Atty. JAK/ih Due Date 04, 27, 04
Mo. Day Yr.



Form 0-00

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00862.003016



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.)	
	:	Group Art Unit: 2854
Application No.: 09/374,580)	
	:	
Filed: August 16, 1999)	
	:	
For: PRINTING HEAD, HEAD)	
CARTRIDGE HAVING	:	
PRINTING HEAD,)	
PRINTING APPARATUS	:	
USING PRINTING HEAD,)	
AND PRINTING HEAD	:	
SUBSTRATE)	February 13, 2004

Commissioner for Patents

LETTER RE ERRONEOUS NOTICE OF ALLOWANCE

Sir:

A Notice of Allowance was issued in the above-identified application, on January 27, 2004, but the claims which were allowed were those that existed in the application prior to the Preliminary Amendment dated November 4, 2003, which was duly filed on that day via Certificate of mail.

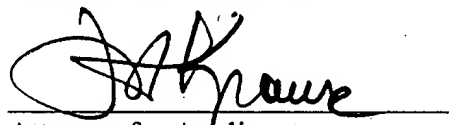
This error was pointed out to the Examiner who recommended that the undersigned contact the PTO at (571) 272-1576. That call was made and the authorities stated that the Preliminary Amendment was in fact received by the PTO and that it would be found and combined with the file.

In this regard, for the convenience of the PTO, attached is a copy of the November 4, 2003, Preliminary Amendment, and a photocopy of the return Postcard indicated that the Preliminary Amendment was duly received by the PTO on November 10, 2003.

It is respectfully requested that the Preliminary Amendment claims be examined prior to the due date of April 27, 2004, for paying the Issue Fee.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


Attorney for Applicants

Registration No. 24,613

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 408146v1

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3 (including cover page)

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Received
Cover
Page
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04/27/2004 17:01 FAX 1212 218 4561

FITZPATRICK N.Y.

0001

FITZPATRICK, CELLA, HARPER & SCINTO

30 Rockefeller Plaza
New York, NY 10112-3801
(212) 218-2100

Facsimile: (212) 218-2200

FACSIMILE COVER SHEET

TO:	Charles Nolan, Jr. U.S. Patent and Trademark Office
FROM:	John A. Krause
RE:	U.S. Patent Application No. 09/374,580 Atty. Docket: 00862.003016
FAX NO.:	1-703-872-9306
DATE:	April 27, 2004
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MESSAGE

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APR 27 2004

FITZPATRICK, CELLA, HARPER & SCINTO

00862.003016

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.)	
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For: PRINTING HEAD, HEAD)	
CARTRIDGE HAVING	:	
PRINTING HEAD,)	
PRINTING APPARATUS	:	
USING PRINTING HEAD,)	
AND PRINTING HEAD	:	
SUBSTRATE)	April 27, 2004

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450


LETTER RE WITHDRAWAL OF APPLICATION
FROM ISSUE PURSUANT TO MPEP §714.15

Sir:

A Request for Continued Examination was filed in the above-identified application on August 4, 2003, followed by the filing of a Preliminary Amendment on November 4, 2003, by means of which additional claims were filed.

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703-872-9306) on

April 27, 2004

	
John A. KRAUSE	
(Name of Attorney for Applicant)	
Signature	April 27, 2004


A Notice of Allowance was issued on January 27, 2004, but that Notice did not refer to the claims of the Preliminary Amendment which had been filed almost three months earlier.

In response to inquiries made to the Patent and Trademark Office, the undersigned was informed that the Preliminary Amendment would be found and reviewed.

The undersigned has now been informed that Claims 59 and 64 must be reviewed further before they can be allowed. Accordingly, pursuant to MPEP §714.15, the Issue Fee is not being paid today, with the understanding that the application will be withdrawn from issue for further examination.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

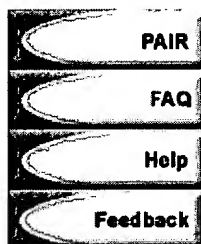
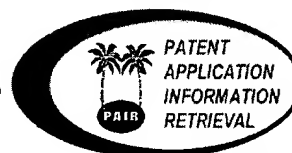
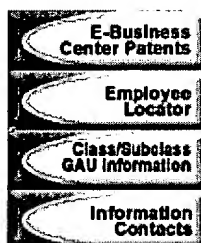


Attorney for Applicants

Registration No.

24613

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Facsimile: (212) 218-2200


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Image File Wrapper for Application No.:09/374,580

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10/27/1999	Miscellaneous Incoming Letter	PROSECUTION
10/27/1999	Oath or Declaration filed	PROSECUTION

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08/16/1999	Claims	PROSECUTION
08/16/1999	Specification	PROSECUTION
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08/16/1999	Search information including classification, databases and other search related notes	PROSECUTION
08/16/1999	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION

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